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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,972	07/18/2003	Russell Mark Earnes	MS#303380.1 (5059)	3011
321	7590	09/21/2006	EXAMINER	
SENNIGER POWERS ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			PARK, ILWOO	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,972

Applicant(s)

EAMES ET AL.

Examiner

Ilwoo Park

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 29-43, 51-53 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28, 44-50, 54, and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/22/03, 8/11/05, 1/25/06, 4/17/06, 5/17/06, 6/1/06, 7/12/06, 8/11/06.

DETAILED ACTION

1. Previous Restriction requirement mailed on 8/2/2005 has been withdrawn. During a telephone conversation with Brian P. Klein on 8/19/05 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-28, 44-50, 54, and 55. Group II, claims 29-43, 51-53, and 56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 44-50, 54, and 55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In view of Applicant's disclosure, specification page 16, paragraph 0041, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., the various computer storage media applicant state such as RAM, ROM, EEPROM) and intangible embodiments (e.g., communication media applicant state such as data structures, carrier wave). As such, the claims are not limited to statutory subject matter and is therefore non-statutory. To overcome this rejection the claims need to be amended to include only the physical computer media and not a communication/transmission media or other intangible or non-functional media.

Claim Rejections - 35 USC § 112

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "said user" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5, 44, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Chung et al. [US 2003/0084460 A1].

As per claim 1, Chung et al teach a method for retrieving metadata [e.g., reproducing control file, markup document in paragraph 0057] for a media file accessible via a media player [reproducing apparatus 200 in fig. 1], said metadata including property data associated with said media file, comprising:

determining [e.g., step 901 in fig. 9, steps 1001, 1002 in fig. 10] that said media file is accessed by said media player;

submitting [paragraphs 0063, step 1008 in fig. 10] an identification parameter associated with said accessed media file to a server when said determining that said media file is accessed by said media player indicates that said media file is accessed [e.g., step 901 in fig. 9, step 1001 in fig. 10] by said media player; and

receiving [e.g., step 904 in fig. 9, step 1009 in fig. 10] from said server said property data corresponding to the accessed media file.

6. As for claim 2, Chung et al teach rendering said received property data on said media player for use by a user of said media player [e.g., step 905 in fig. 9, step 1011 in fig. 10].

7. As for claim 3, Chung et al teach determining [e.g., typically identifier is recorded on the disc in paragraph 0063] whether said identification parameter is stored on said media player, determining [step 902 in fig. 9] whether said property data is stored on said media player, and caching [cache memory 3 in paragraph 0063] said received property data with a collection ID [downloaded markup document contains a client execution code recognizing a disc identifier in paragraph 0075, 'big hits' in paragraph 0061] when said determining whether said identification parameter is stored on said media player indicates that said identification parameter is stored [e.g., typically identifier is recorded on the disc in paragraph 0063] on said media player and when said determining whether said property data is stored on said media player is not stored [e.g., steps 902, 904 in fig. 9, steps 1002, 1003, 1005 in fig. 10] on said media player, said determining whether said identification parameter is stored on said media player

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and determining whether said property data is stored on said media player both occurring before [figs. 9 and 10] said submitting.

8. As for claim 5, Chung et al teach the collection ID defines a music album comprising multiple media files accessible by said media player [e.g., 'big hits' in paragraphs 0060, 0068].

9. As for claims 44 and 55, Chung et al also teach a computer-readable medium having computer-executable instructions for performing a method discussed above.

10. Claims 1-28, 44-50, 54, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka et al. [US 2005/0203992 A1].

As per claim 1, Tanaka et al teach a method for retrieving metadata [e.g., paragraph 0111] for a media file accessible via a media player [terminal 1 in fig. 1], said metadata including property data associated with said media file, comprising:

determining [e.g., paragraphs 0236, 0239, 0380] that said media file is accessed by said media player;

submitting [paragraphs 0256, 0382] an identification parameter associated with said accessed media file to a server when said determining that said media file is accessed by said media player indicates that said media file is accessed [e.g., step 901 in fig. 9, step 1001 in fig. 10] by said media player; and

receiving [e.g., paragraphs 0259, 0383] from said server said property data corresponding to the accessed media file.

11. As for claim 2, Tanaka et al teach rendering said received property data on said media player for use by a user of said media player [e.g., paragraph 0384].
12. As for claim 3, Tanaka et al teach determining [e.g., paragraphs 0242-0244] whether said identification parameter is stored on said media player, determining [paragraph 0252] whether said property data is stored on said media player, and caching [paragraph 0261] said received property data with a collection ID [fig. 7] when said determining whether said identification parameter is stored on said media player indicates that said identification parameter is stored [e.g., typically identifier is recorded on the disc in paragraph 0063] on said media player and when said determining whether said property data is stored on said media player indicates that said property data is not stored [paragraph 0252] on said media player, said determining whether said identification parameter is stored on said media player and determining whether said property data is stored on said media player both occurring before [figs. 8 and 9] said submitting.
13. As for claim 4, Tanaka et al teach said identification parameter is a content ID cached on said media player during prior access of said media file by said media player [paragraphs 0243, 0380].
14. As for claims 5, 8, and 10, Tanaka et al teach said collection ID defines a music album comprising multiple media files accessible by said media player [fig. 7; paragraph 0219].
15. As for claim 6, Tanaka et al teach determining [e.g., paragraphs 0242-0244] whether said identification parameter is stored on said media player,

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determining [paragraph 0252] whether said property data is stored on said media player, determining [fig. 18; paragraph 0341] whether an artist ID is a known various artists value on said media player, and caching [paragraph 0354] said received property data with a collection ID [fig. 7] when said determining whether said identification parameter is stored on said media player indicates that said identification parameter is stored [paragraphs 0242-0244] on said media player, when said determining whether said property data is stored on said media player indicates that said property data is not stored [paragraph 0252] on said media player, and determining whether an artist ID is a known various artists value on said media player indicates that an artist ID is a known various artists value on said media player [e.g., Billy Eva, Mill David in fig. 18], said determining whether said identification parameter is stored on said media player, determining whether said property data is stored on said media player, and said determining whether an artist ID is a known various artists value on said media player all occurring before said submitting.

16. As for claim 7, Tanaka et al teach said identification parameter is a content ID cached on said media player during prior access of said media file by said media player [paragraphs 0259-0261].

17. As for claim 9, Tanaka et al teach determining [paragraphs 0236, 0237] whether a content ID associated with said accessed media file is stored on said media player, and caching [paragraph 0236; fig. 7] said received property data with a collection ID when said determining whether a content ID associated with said accessed media file is stored on said media player indicates that said

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content ID is not stored on said media player, said determining whether a content ID associated with said accessed media file is not stored on said media player occurring before said submitting.

18. As for claim 11, Tanaka et al teach said submitted identification parameter is a Table of Contents (TOC) stored with said media file [paragraph 0217].

19. As for claim 12, Tanaka et al teach receiving a content ID associated with said accessed media file for subsequent submitting of said content ID as an identification parameter associated with said media file to said server [e.g., fig. 23].

20. As for claim 13, Tanaka et al teach said media file is stored on a compact disk for access of said media file via said media player [paragraph 0099].

21. As for claim 14, Tanaka et al teach said TOC is a compact disc table of contents cataloging media files stored on said compact disc [paragraph 0160].

22. As for claim 15, Tanaka et al teach said identification parameter is at least one of a content ID, a compact disc table of contents (TOC), an AMG album ID (AID), an AMG performer ID (PID), an MSID person, an MSID album and a genre for identifying said media file [paragraph 0217].

23. As for claim 16, Tanaka et al teach said media player comprising a computer and a CD-ROM drive, said media file being stored on a compact disc inserted into the CD-ROM drive of the computer [fig. 3].

24. As for claim 17, Tanaka et al teach said media file is a song and property data is associated with said song [fig. 7].

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25. As for claim 18, Tanaka et al teach retrieving stored data from said media player relating to said media file, said stored data comprising data input by a user [paragraph 0230].

26. As for claim 19, Tanaka et al teach said stored data is at least one of a rating of said media file, textual information relating to said media file and lyrics associated with said media file [paragraph 0223].

27. As for claim 20, Tanaka et al teach a method for retrieving metadata for a media file accessible via a media player [terminal 1 in fig. 1], said metadata including property data associated with said media file, comprising:

determining [paragraph 0216] whether a first identification parameter associated with said media file is stored on said media player;

submitting [paragraph 0216] a second identification parameter associated with said accessed media file to receive said property data from a server when said determining whether a first identification parameter associated with said media file is stored on said media player indicates said first identification parameter is not stored on said media player;

determining [paragraph 0242] whether said property data is stored on said media player when said determining whether a first identification parameter associated with said media file is stored on said media player indicates said first identification parameter is stored on said media player;

submitting [paragraph 0256; fig. 21] said first identification parameter associated with said accessed media file to receive said property data from a

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server when said determining whether said property data is stored on said media player indicates said property data is not stored on said media player;

determining [fig. 18; paragraph 0341] whether an artist ID is a known various artists value on said media player when said determining whether said property data is stored on said media player indicates said property data is stored on said media player;

submitting said first identification parameter associated with said accessed media file to receive said property data from a server when said determining whether an artist ID is a known various artists value on said media player indicates said artist ID is a known various artists value [e.g., Billy Eva, Mill David in fig. 18]; and

rendering said property data on said media player when said determining whether an artist ID is a known various artists value on said media player indicates said artist ID is not a known various artists value [e.g., John Call, Sarra V in fig. 18; paragraph 0345].

28. As for claim 21, Tanaka et al teach each of said submitting further comprising retrieving said property data from said server [figs. 9, 16, 21].

29. As for claim 22, Tanaka et al teach each of said submitting further comprising rendering said property data on said media player [figs. 9, 16, 21].

30. As for claim 23, Tanaka et al teach determining that said media file is accessed by said media player, said determining that said media file is accessed occurring before said determining whether a first identification parameter associated with said media file is stored on said media player [fig. 8].

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31. As for claim 24, Tanaka et al teach said first identification parameter is a content ID associated with said accessed media file [fig. 21].

32. As for claim 25, Tanaka et al teach said second identification parameter is a table of contents (TOC) associated with said accessed media file [paragraph 0238].

33. As for claim 26, Tanaka et al teach said media file is stored on a compact disc [paragraph 0099].

34. As for claim 27, Tanaka et al teach a method for rendering metadata for a media file accessible via a media player [terminal 1 in fig. 1], said metadata including property data associated with said media file, comprising:

determining [paragraphs 0236-0239] that the media file is accessed by the media player;

identifying [paragraphs 0239-0240] an identification parameter of said media file stored on said media player when said determining that the media file is accessed by the media player indicates that the media file is accessed by the media player;

determining [paragraphs 0251-0252] that said property data associated with said identification parameter of said accessed media file is stored on said media player; and

rendering [paragraph 0384] said property data stored on said media player.

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35. As for claim 28, Tanaka et al teach a method for rendering metadata for a media file accessible via a media player [terminal 1 in fig. 1], said metadata including property data associated with said media file, comprising:

requesting said property data from a server when at least one of (a) a content ID is not stored [paragraph 0216] on said media player, (b) said property data is not stored [paragraph 0252] on said media player, (c) an artist ID is a known various artists value [e.g., Billy Eva, Mill David in fig. 18] are true;

accessing said property data stored on said media player when (a), (b), and (c) are false [e.g., John Call, Sarra V in fig. 18; paragraph 0345]; and

rendering said property data.

36. As for claims 44-50, 54, and 55, Tanaka et al teach also teach a computer-readable medium having computer-executable instructions for performing a method discussed above.

Claim Rejections - 35 USC § 103

37. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

38. Claims 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al. [US 2003/0084460 A1] in view of Roberts et al. [US 6,154,773].

As for claim 4, Chung et al teach said identification parameter is a content ID [e.g., disc identifier, video title identifier] recorded on the disc and retrieved

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during prior access of said media file by said media player [paragraph 0065].

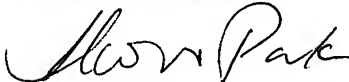
Though Chung et al teach the identification parameter is used multiple times [paragraphs 0066, 0067] for retrieving markup data and reproducing control file from the server, Chung et al do not explicitly disclose either said identification parameter cached on said media player and used when the next retrieval or said identification parameter retrieved from the disc whenever needed. Quinn et al teach a method for retrieving metadata by using an identification parameter and a cache stores the identification parameter. At the time the invention was made, one of ordinary skill in the art would have been obvious to modify to include the identification parameter stored in a cache in order to reduce access time to retrieve the identification parameter from a cache rather than a disc which takes longer time.

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Conclusion

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ilwoo Park whose telephone number is (571) 272-4155. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ILWOO PARK
PRIMARY EXAMINER


Ilwoo Park

September 15, 2006